

REMARKS

Claims 1, 3-20, 22-24, 27-39, 43, 45, 47, 49-51, and 53-59 are pending in this application after this Amendment. Claims 1, 20, 39, 43, 45, 47, and 51 are independent. Claims 41, 48, and 52 have been canceled without prejudice or disclaimer to the subject matter contained therein. Claims 55-59 have been added. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 3, 4-20, 22-24, 27-39, 41, 43, 45, and 47-54 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* (USP 5,652,412) in view of *Hecht et al.* (USP 6,327,395). Applicants respectfully traverse these rejections.

By this Amendment, Applicants have amended the claims to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

Claim Rejections - 35 U.S.C. § 103

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the present invention as set forth in claim 43 recites, *inter alia*, a system for information management, comprising a sensing wand and a sensed product provided with at least one activation icon indicating a predetermined operation and identified by at least one position code, **the sensing wand being adapted to initiate the predetermined operation for the recorded information obtained from the writing region in response to the detection of the at least one activation icon on the product by detection of the at least one position code.**

In support of the Examiner's rejection of claim 43, the Examiner asserts that *Lazzouni et al.* discloses a sensing wand pen and a sensed product supplying the position information to the sensing wand and being provided with a writing region, citing to col. 6, lines 35-65. The Examiner admits that *Lazzouni et al.* does not teach or suggest a sensed product provided with at least one activation icon. The Examiner relies on the teachings of *Hecht et al.* to cure the teachings of *Lazzouni et al.* by asserting that *Hecht et al.* teaches at least one

activation icon, e.g., icon David's DOC2, citing to col. 10, line 66 - col. 11, line 7 and col. 11, line 57 - col. 12, line 41.

At the outset, it is respectfully submitted that the Examiner has failed to mention in his rejection of claim 43 the claim element of the sensing wand being adapted to initiate the predetermined operation **for the recorded information obtained from the writing region** in response to the detection of the at least one activation icon on the product, as recited in claim 43. The Examiner has failed to provide any support in the form of citations to either the *Lazzouni et al.* reference or the *Hecht et al.* reference that teaches or suggests this claim element. As it is unclear both as to which reference the Examiner is relying upon to teach this claim element and which specific portion of the reference the Examiner is relying upon to teach or suggest this claim element, it is difficult for Applicants to adequately respond to the Examiner's rejection. If the Examiner maintains the outstanding rejection, it is respectfully requested that the Examiner issue a new, non-final Office Action explicitly stating how the Examiner is applying the references to teach or suggest this claim element.

In addition to the above, it is respectfully submitted that neither of the references, either alone or in combination (assuming these references are combinable, which Applicants do not admit), teach or suggest this claim element. Applicants further respectfully disagree with the Examiner's characterization of the *Lazzouni et al.*

and *Hecht et al.* references. It is respectfully submitted that the disclosure of *Hecht et al.* is directed to a glyph address carpet method and apparatus for providing location information in a multidimensional address space. *Hecht et al.* provides for a human interpretable textual, graphical, or mixed textual and graphical representation of files that are accessible via a user interface and are spatially registered in superimposed or juxtaposed relationship with respective addresses in an address space. The spatial addresses are logically registered in a lookup table or the like with computer recognizable descriptions of the respective file names and, if needed, paths to the directories for the named files (col. 4, lines 6-14).

In other words, *Hecht et al.* merely provides for an interface that allows a user to select a file. As the Examiner appears to be equating the predetermined operation as recited in claim 43 with the selecting of a file icon, it is respectfully submitted that there is no teaching or suggestion in *Lazzouni et al.* that provides for initiating the predetermined operation for the recorded information obtained from the writing region in response to the detection of the at least one activation icon as recited in claim 43. As such, it is respectfully submitted that as neither *Lazzouni et al.* nor *Hecht et al.*, either alone or in combination, teach or suggest this claim element, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

In addition to the above arguments, it is respectfully submitted that the Examiner has failed to provide proper motivation for combining the teachings of *Hecht et al.* with the teachings of *Lazzouni et al.* As noted above, the present invention of claim 43 includes, *inter alia*, a sensed product being provided with a writing region and at least one activation icon. The Examiner utilizes the teachings of *Lazzouni et al.* to purportedly provide the writing region and utilizes the teachings of *Hecht et al.* to purportedly teach the at least one activation icon. In providing motivation to combine the teachings of the two references, the Examiner asserts:

Therefore, it would have been obvious to one of ordinary skill in the art at the [time the] invention was made to have added a user interface icon as taught by Hecht to the encoded paper of Lazzouni because human interpretable textual, graphical or mix textual and graphical representations of files can be accessible via the user interface icon (see column 4, lines 6-15 of Hecht).

While the above statement provides for a motivation to utilize, *arguendo*, at least one activation icon, as taught by *Hecht et al.*, this statement fails to provide motivation to combine the writing region of *Lazzouni et al.* with the at least one activation icon of *Hecht et al.*

In addition to the fact that the above statement made by the Examiner fails to rise to the level of valid motivation under 35 U.S.C. § 103, as noted above, *Hecht et al.* fails to teach or suggest initiating a predetermined operation for the recorded information as

recited in claim 43. As previously asserted, *Hecht et al.* teaches initiating a predetermined operation for the activation icon that is selected by the user, e.g., David's DOC2. There is no teaching or suggestion in *Hecht et al.* that is directed to initiating a predetermined operation for the recorded information obtained from the writing region. As *Hecht et al.* fails to teach or suggest this element, it is respectfully submitted that there is no proper motivation to combine the elements as asserted by the Examiner.

As neither of the references provide any motivation to combine the teachings of *Lazzouni et al.* with the teachings of *Hecht et al.*, it appears that the Examiner is relying on Applicants' specification for the valid motivation. It is respectfully submitted that the Examiner's reliance on Applicants' specification amounts to impermissible hindsight.

For the above reasons, it is respectfully submitted that, as the Examiner has failed to provide references that teach or suggest all the claimed elements, and as the Examiner has failed to provide valid motivation for combining the references, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 1, 20, 39, 45, 47, and 51 contain elements similar to those discussed above with regard to claim 43 and, thus, these claims, together with claims dependent

thereon, are allowable for the reasons set forth above with regard to claim 43.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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(Rev. 02/12/2004)